

## **REMARKS**

Reconsideration of this Application is respectfully requested. Claims 15-21, 23-29, 32-36 and 38-52 are pending in the application, with claims 15, 23, 28, and 34 being the independent claims. New claims 50-52 have been added.

### ***Interview Summary***

The undersigned appreciated the Examiners' time and attention during the interview conducted on Thursday, March 13, 2008. During the interview, independent claims 15, 23, 28 and 34 were discussed with respect to a commercial product and the cited art. Although a commercial product was demonstrated and features of this commercial product were discussed, it should be understood that this commercial product is an example of one embodiment and that other embodiments are possible. Thus, the claims should be understood by their recitations, and features of this commercial product are not requirements of the claims.

### ***Rejections Under 35 U.S.C. § 112***

Claims 23, 40, 43, 46 and 49 were rejected under the first paragraph of 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the examiner stated that the claims contain subject matter which was not described in the specification in such a way to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 23, 40, 43, 46 and 49 have been amended, as discussed below, to expedite prosecution without acquiescing to the rejections under 35 U.S.C. § 112, first paragraph.

Independent claim 23 has been amended to delete the claim language “independent of biometric data.” More particularly, independent claim 23 has been amended to recite “producing a digital certificate based on the identifier and before enrollment of biometric data.” The rejection of independent claim 23 is traversed for at least the following reason that independent claim 23 as amended complies with the written description requirement. Accordingly, the Applicants request that the rejection of independent claim 23 under the first paragraph of 35 U.S.C. § 112 be withdrawn.

Dependent claims 40, 43, 46 and 49 has been amended to delete the claim language “excludes biometric data” from each claim. More particularly, dependent claim 40 has been amended to recite “the digital certificate includes data associated with the personal identification device.” Dependent claim 43 has been amended to recite “the digital certificate is based on data associated with the personal identification device.” Dependent claim 46 has been amended to recite that “the digital certificate includes data associated with the apparatus.” Dependent claim 49 has been amended to recite that “the digital signature includes data associated with the personal identification device.” The rejection of dependent claims 40, 43, 46 and 49 is traversed for at least the following reason that dependent claims 40, 43, 46 and 49 as amended comply with the written description requirement. Accordingly, the Applicants request that the rejection of dependent claims 40, 43, 46 and 49 under the first paragraph of 35 U.S.C. § 112 be withdrawn.

***The Claims are Patentable Over Russo***

Claims 23-27 and 41-43 stand rejected under 35 U.S.C. 102(e) as being unpatentable over U.S. Publication No. 2003/0115475 to Russo et al. ("*Russo*"). This rejection is overcome for the reasons below.

Unlike independent claim 23, which recites "producing a digital certificate ... before enrollment of biometric data" and which has been amended to recite "sending the digital certificate to the personal identification device such that the functionality of the personal identification device is disabled except that the personal identification device is configured to send the digital certificate to an enrollment party during future enrollment," *Russo* is entirely silent. *Russo* merely discloses sending a biometrically-enhanced certificate to a device. *Russo*'s biometrically-enhanced certificate is not produced "before enrollment of biometric data" because the user's biometric data is used in the formation of the biometrically-enhanced certificate after enrollment. Once the biometrically-enhanced certificate has been received, the device is fully functional. Even before receiving the biometrically-enhanced certificate, enrollment has occurred and the device is operational. In sum, as discussed during the interview, *Russo* is directed to enrollment and post-enrollment processes and not to pre-enrollment processes in which functionality has been disabled. Accordingly, the Applicants request that the rejection of independent claim 23 and its dependent claims 24-27 and 41-43 under 35 U.S.C. § 102(e) be withdrawn.

***The Claims are Patentable Over Russo in View of Anthony***

Claims 15-21, 28-29, 32-36, 38-40 and 42-49 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Russo* in view of U.S. Publication No. 2003/0115490 to Russo et al. (“*Anthony*”). This rejection is overcome for the reasons below.

Unlike independent claim 15, which has been amended to recite “disabling functionality within the personal identification device except that the personal identification device is in a wait state associated with future enrollment,” *Russo* in view of *Anthony* is entirely silent. *Anthony* merely discloses a storage module that is unlocked after matching biometric data during post-enrollment use. To match biometric data, the storage module compares a biometric template and a biometric input. The storage module has functionality other than being in a wait state associated with future enrollment (e.g., unlocking upon a biometric match of a user). In fact, *Russo* in view of *Anthony* fails to disclose or suggest any type of wait state associated with future enrollment. Accordingly, the Applicants request that the rejection of independent claim 15 and its dependent claims 16-21 and 38-40 under 35 U.S.C. § 103(a) be withdrawn.

Unlike independent claim 28, which has been amended to recite a “processor configured to disable functionality of the memory and the processor associated with a party other than an enrollment party,” *Russo* in view of *Anthony* is entirely silent. *Anthony* merely discloses a storage module that is unlocked after a biometric data match of a user. For a biometric data match to be completed, the storage module compares a biometric template and a biometric input. Thus, the storage module has functionality associated with the user (e.g., an enrolled party) who is not an enrollment authority. Accordingly, the Applicants request that the rejection of independent claim 28 and its dependent claims 29, 32-33 and 44-46 under 35 U.S.C. § 103(a) be withdrawn.

Unlike independent claim 34, which has been amended to recite “disabling functionality within the personal identification device except for functionality associated with future enrollment,” *Russo* in view of *Anthony* is entirely silent for at least the reasons discussed above with respect to claim 15.

Moreover, unlike independent claim 34, which recites “receiving an encryption identifier at a personal identification device from a party during pre-enrollment,” *Russo* in view of *Anthony* fails to disclose or suggest receiving an encryption identifier during pre-enrollment. Accordingly, the Applicants request that the rejection of independent claim 34 and its dependent claims 35-36 and 47-49 under 35 U.S.C. § 103(a) be withdrawn.

#### ***New Claims are Patentable***

New claims 50-52 are patentable. More particularly, dependent claim 50 is patentable for at least the reason that it depends from independent claim 15. Dependent claim 51 is patentable for at least the reason that it depends from independent claim 28. Dependent claim 52 is patentable for at the reason that it depends form independent claim 34.

#### ***Conclusion***

All of the stated grounds of rejection have been properly overcome. The Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. The Applicants believe that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that further personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this application is respectfully requested.

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Respectfully submitted,

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